REMARKS

Please enter the amendments to claims 1 and 15. Support for these amendments may be found in the specification at paragraph [0028]. No new matter is believed to have been added on entry of these amendments.

The following issues are outstanding in the present application:

- Claims 1-7 have been rejected under 35 U.S.C. § 103(a);
- Claims 9 and 21-23 have been rejected under 35 U.S.C. § 103(a);
- Claims 10-12 have been rejected under 35 U.S.C. § 103(a);
- Claims 13 and 14 have been rejected under 35 U.S.C. § 103(a); and
- Claims 15-18 have been rejected under 35 U.S.C. § 103(a).

35 U.S.C. § 103(a)

The Examiner has again rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over Oosterlinck in view of Warther. Applicant respectfully traverses the rejection:

Claim 1 as amended is patentable - The function of Oosterlinck and the function of Warther would both be destroyed in the combination proposed by the rejection. There is no motivation to combine the references, nor any reasonable expectation of success for making triangular-shaped labels according to the claimed invention even if such a combination were attempted as Warther teaches away from the desirability of making triangular-shaped labels.

Oosterlinck teaches a device and method for preparing labels and attempts to overcome problems with label cutting/preparation techniques in the prior art by using a label cutting apparatus that converts a base stock into releaseably-lined labels by 1) separating a face web and a backing layer, 2) cutting a label from the face web while a vacuum roller holds the face web during the label cutting step (the shapes are unspecified), and 3) pressing the cut label back onto the backing liner to form the releaseably-lined labels: this process is said to be an improvement over the prior art, described at column 1, lines 18-39. In summary, Oosterlinck only teaches a device and method for making cut-out labels, but

suggests no shapes of labels which are possible. Nor does he teach or suggest a scoring step.

Warther, in contrast, is directed to a scored or perforated sheet (Col. 3, ll. 3-27), not a cut sheet, for data storage tags that may or may not also embody additional scored rectangular or square-shaped "label" portions. The label portions may be additionally covered with an adhesive and a release layer for attachment to the tag (Col. 9., ll.46-57).

The sheet is made from a printable sheet material core having a pair of opposing major sides that may or may not be printed upon (Col. 7, lines 28-30). Both sides of the core are covered with transparent film layer or web material that may be any material that is suitably and sufficiently transparent that can be applied to the core material without adversely affecting the core or the printing thereon (Col. 7, lines 61 and 62). The transparent layers are adhered to the core by means of an adhesive appropriate for use with the specific core material. These transparent layers are permanently adhered to the core (see. Col. 8, ll. 5-20). This basic structure is then scored, not cut.

But notably, there is no teaching or suggestion of an adhesive layer and a liner/release paper covering the entire sheet, including the label portions according to the present invention. Further, Applicant asserts that the statement made on page 3 of the Advisory Action that the magnetic strips correspond to the liner of the present invention is incorrect. These two elements, liner, and magnetic strips share no common or equivalent function. Warther only teaches a printed sheet product composed of a core having transparent sheets permanently adhered to the core that may have various shapes, defined by scoring, which must subsequently be torn from a sheet to yield a shaped tag and optionally, a square or rectangular shaped label. Warther is silent as to how his scored sheets are made.

In contrast to the cited references, Independent claim 1 is directed to an adhesive label produced by a process that includes the steps of: (1) providing a web consisting of an adhesive label substrate having a face material, an adhesive layer and a liner; (2) positioning the web in a label conversion machine wherein the web is continuously pulled through the conversion machine in a preselected web direction; (3) configuring a plurality of triangular shaped labels on the face material in which each label has a first, second and third side wherein the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width; (4) cutting the plurality of triangular shaped labels on the web to form a plurality of cut triangular

shaped labels; (5) printing the plurality of triangular labels; and (6) processing the plurality of triangular labels into individual rolled strips.

The 35 USC § 103 rejection of claim 1 over Oosterlinck, in view of Warther, requires that one having ordinary skill in the art would know how to make the triangular labels according to claim 1 by taking the Warther teaching of a scored three layer sheet product, the layers being permanently attached, and use the process described in Oosterlinck, to form the claimed releaseably lined label. One of skill in the art would have to know how to cut and form a plurality of lined triangular shaped labels that are oriented in a particular fashion relative to the sheet and to each other on the same sheet.

But the shaped tags of Warther are not formed from a face web, an adhesive layer and a backing/release layer, nor are they cut from a face web to form separate labels as required by Oosterlinck: Warther only teaches scoring sheets having a core and two transparent layers that are permanently glued onto the core to define tags, the tags having magnetizable data strips permanently attached on to the laminated core, nothing more. A sheet, including the tag, is never taught or suggested as coverable with an adhesive layer and a backing layer, nor is there any teaching or suggestion of a liner according to the present invention.

Accordingly, there would be no reason why one skilled in the art would attempt to combine the teachings in these references because the function of both references would be destroyed in the proposed combination. Oosterlinck differs from Warther in that the backing layer of Oosterlinck is apparently reversibly attached while the so-called backing or liner layer in Warther is in fact permanently attached. The two are quite different in both structure and function. If a proposal for modifying a prior art reference, in an effort to attain a claimed invention, causes the reference to become inoperable or destroys it intended function, then the requisite motivation to make the modification would not have existed. *In re Gordon* 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed.Cir. 1984).

Applicant again disagrees with the characterization stated in the Advisory Action of June 30, 2003 that the magnetizable strips (items 31-34) in Warther correspond to the backing/release layer of claim 1. These items are permanently attached to the composite of the core and transparent layers. If these strips were removable then the function of Warther would be destroyed. In fact, these strips are required for the Warther invention to work. Why would they be removable? Accordingly, the structure of Warther's tags are not labels in

the sense of the present invention and thus, the proposed combination of references is improper.

Additionally, Warther teaches scored sheets with numerous tag shapes, including: "generally quadrilateral", "teardrops", "right triangles" and "isosceles triangles" – each of the latter two in associated quadrilateral shaped pairs to ease their removal from the scored sheet. But at col. 7, line 15-21 he states:

> "the triangular removable elements do not lend to easy subdivision of the sheet products...the more rectangularly arranged removable elements ...of sheet products respectively do lend to subdivision of the sheet products into smaller sheet products including at least one of the pairs of the removable elements...".

So, in contrast to the current rejection of claim 1, it is respectfully suggested that a person having ordinary skill in the art would know that Warther considers triangle shapes as difficult to remove from a scored sheet and he prefers to make more rectangularly shaped removable elements (see col. 7., l. 15-21). Thus, given the variety of shapes disclosed in Warther, and the apparent difficulty in removing triangular-shaped pieces from a scored sheet, why would one of ordinary skill look to this reference for guidance into making a triangular-shaped label that has a liner according to claim 1? How can there be any expectation of success for this proposed combination of references? In contrast to the unsupported rejection of claim 1, Applicant respectfully asserts that there is no teaching or suggestion found in Warther that would motivate one of skill in the art to combine the references in order to produce the invention of claim 1.

Although the motivation stated in the current rejection may or may not be driving the inventors in the instant case, the only potential teaching for such motivation is clearly Applicant's own patent application. Using Applicant's own invention to supply the motivation for combining references is inappropriate. As stated in MPEP § 2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ 1430 (Fed.Cir. 1990). Accordingly, as there is no desirability for the proposed combination as described above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claim 1 under 35 U.S.C. § 103(a) as having subject matter obvious over Oosterlinck in view of Warther.

35 U.S.C. § 103(a)

If an independent claim is non-obvious under 35 U.S.C. § 103(a), then any claim depending therefrom is by definition non-obvious. *In re Fine*, 5 USPQ 2d. 1596 (Fed. Cir. 1988). Applicant respectfully submits that claims 2-7 depend at least in part from amended independent claim 1 and therefore are non-obvious over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 2-7 under 35 U.S.C. § 103(a) as being unpatentable over Oosterlinck and Warther.

35 U.S.C. § 103(a)

The Examiner has rejected claims 9, 21, and 23 under 35 U.S.C. § 103(a) as having subject matter unpatentable over Oosterlinck in view of Warther, and further in view of Kirk and further in view of the specification at page 1, paragraph [0003]. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion regarding the patentability of the subject invention over the combination of Oosterlink and Warther obviates the present rejection of these claims. Kirk nor paragraph [0003] in the specification add nothing to the Oosterlinck and Warther rejection that makes claim 1 obvious. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988). Claim 9 depends at least in part from independent claim 1 and claims 21 and 23 depend at least in part from independent claim 15 (see discussion below concerning the patentability of claim 15). Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of Kirk and the specification at page 1, paragraph [0003] the rejection should be withdrawn.

35 U.S.C. § 103(a)

The Examiner has rejected claims 10 and 12 under 35 U.S.C. § 103(a) as having subject matter unpatentable over Oosterlinck in view of Warther, and further in view of the specification regarding printing color on the plurality of labels and the color related to an industry standard color code system. Applicant respectfully traverses.

Applicant respectfully submits that the previous discussion of the patentability of the

subject invention over the combination of Oosterlink and Warther obviates the present rejection of these claims. The discussion in the specification related to printing and color standards adds nothing to cure the deficiencies of the primary rejection. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988). Claim 10 and 12 depend at least in part from independent claim 1. Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003].

35 U.S.C. § 103(a)

The Examiner has rejected claims 13 and 14 under 35 U.S.C. § 103(a) as having subject matter unpatentable over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003]. Applicant respectfully traverses.

Applicant submits that the previous discussion of the patentability of the subject invention over the combination of Oosterlink and Warther obviates the present rejection of these claims. The disclosure in paragraph [0003] adds nothing to cure the deficient rejection of claim 1. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988). Claim 13 and 14 depend at least in part from independent claim 1. Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003].

35 U.S.C. § 103(a)

The Examiner has newly rejected claims 15-18 under 35 U.S.C. § 103(a) as having subject matter unpatentable over Oosterlinck in view of Warther, further in view of Kirk and in further view of the description in the specification on page 1 at paragraph [0003].

With respect to independent claim 15, Applicant respectfully traverses the rejection in part based on the previous discussion(s) of the rejection of Oosterlinck in view of Warther in regards to claim 1, further in view of Kirk, further in view of the description in the specification at page 1, paragraph [0003]; and for the additional following reasons: As the Action notes, Oosterlinck, Warther, and Kirk, fail to teach that the triangular shaped label has sides of equal length. The only teaching or suggestion of any remotely triangular shape are

the tags (not the labels) in Warther and those are described as "generally isosceles" or "right triangular" and they preferably are arranged in matched pairs that resemble rectangles. But triangles with sides of equal length are not taught or suggested. Further, these references fail to teach or suggest that the entire sheet is covered with a liner layer.

With respect to the assertion in the Official Action of April 10, 2003 and the Advisory Action of June 27, 2003 that the number of triangles having sides of equal length could be conceived and maximized through routine experimentation, Applicant respectfully suggests there must first be some teaching or suggestion that such triangles would in fact maximize the number of such labels on a sheet and nowhere is that fact taught or suggested. Where in Warther or in the knowledge of the skilled artisan is such information taught?

The only thing Warther teaches is increasing the number of tags by excluding the label portions from a sheet. To be clear, the Advisory Action appears to be stating that even though Warther doesn't teach triangles having sides of equal length it would have been obvious to do routine experimentation to yield a different triangular shape (having sides of equal length) and then experiment to arrange these new triangular shapes so as to maximize their number on the sheet. But since none of the references teach or suggest triangles having sides of equal length, the line of reasoning proffered in the Advisory Action in regards to making claim 15 obvious must be incorrect as there is no motivation for one of ordinary skill in the art to do such experimentation as suggested. The only place where triangles having sides of equal length are taught is Applicant's own invention. Thus, the Examiner must be relying on prior art within his own knowledge. As stated in M.P.E.P. § 2144.03, if the Examiner relies on personal knowledge, Applicant is entitled to an affidavit by the Examiner, so that the Applicant can refute with specificity the Examiner's assertion. Applicant respectfully request an affidavit from the Examiner showing with specificity a teaching that it would be obvious to change triangular label shapes and arrange them as in Applicant's invention.

Accordingly, Applicant requests reconsideration of claim 15 and that the Examiner withdraw the § 103 rejection based on the cited combination and the Examiner's personal knowledge, or provide a affidavit in compliance with M.P.E.P. § 2144.03.

With regard to the rejection of dependent claims 16-18, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is by definition

nonobvious. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988). Claims 16-18 depend at least in part from independent claim 15. Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003] and the Examiner's line of reasoning in the current Official Action.

With regard to the rejection of dependent claims 21 and 23, Applicant refers the Examiner back to the previous discussion regarding the patentability of claim 1 and the above additional discussion overcoming the rejection of claim 15. Claims 21 and 23 depend at least in part from independent claim 15. Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003] and the Examiner's reasoning in the Official Action. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988).

Applicant respectfully submits that this application is now in condition for allowance. In the event that minor claim amendments are necessary to meet formal requirements, Applicant invites the Examiner to telephone the undersigned so that appropriate amendments can be made.

Respectfully submitted,

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